

REMARKS

Claims 2 and 3 are cancelled. Therefore, claims 1 and 4 are all the claims pending in the application.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji Electric Co., Ltd. (JP 2000-316285) in view of Kobayashi (U.S. Patent No. 5,512,782) and further in view of Miki et al. (U.S. Patent No. 5,055,990).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji Electric Co., Ltd. (JP 2000-316285) in view of Kobayashi (U.S. Patent No. 5,512,782) and further in view of Miki et al. (U.S. Patent No. 5,055,990) and Hitachi (JP 08-251908).

The Applicants traverse the rejections and request reconsideration.

The Applicants respectfully amend claim 1 to include limitations from claims 2 and 3. Because of this amendment only the rejections based on the combined teachings of Fuji, Kobayashi and further in view of Miki and Hitachi remain relevant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Applicants respectfully submit that the patent office has not satisfied the burden of establishing *prima facie* obviousness at least because it has not satisfied at least the “all limitations” and “motivation” prongs of the three prong test for obviousness. Specifically, the patent office has not shown that the combined teachings of Fuji, Kobayashi, Miki and Hitachi suggest the present invention as a whole, including the requirement of having twelve snubber diodes and a capacitor being enclosed in a resin mold such that the six diode external terminals are exposed from the resin mold.

The USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. See, *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), citing, e.g., *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). *In re Lee*, the Federal Circuit went on to emphasize that the “need for specificity pervades this authority.” *In re Lee* at 1433 (emphasis added) (citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”).

The patent office has not established *prima facie* obviousness because it has not shown where in the combined teachings of the cited reference such a combination of circuit element package in a resin mold and the **terminals being exposed is suggested**. Since the “all limitations” prong of the three prong test fails, the “motivation” prong must also fail.

In addition, the Examiner generally asserts that a skilled artisan would have been motivated to combine the teachings of Fuji, Kobayashi, Miki and Hitachi and would be further motivated to expose the terminals in order to “save costs, space and reduce the time to install. The Applicants respectfully disagree. The Federal Circuit has stated unequivocally that most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 99-1231 (CAFC June 2000), *citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Further, every element of a claimed invention may often be found in the prior art. *See id.*

However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *Id.*, *citing, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Kotzab*, 99-1231 (CAFC June 2000, *citing Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

The court in *Kotzab* further accentuates that close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id. quoting W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Federal Circuit appears to be clearly talking about the kind of situation as in the present case. Key aspects of the present invention include providing twelve snubber diodes and a snubber capacitor in an enclosure made of resin mold such that the diode terminals and the capacitor terminals are exposed. The present invention teaches the very act of combining, since the individual bare-bones structural components are arguably in the prior art.

The Examiner has relied on nothing more than a general assertion about the desirability of minimizing space and cost and improving ease of installation. But, the cited references merely use the above-mentioned items in completely different structural combinations. Nowhere, is a motivation suggested to provide the above combination to "save cost and space" as the Examiner alleges, and/or to achieve the advantages noted in the present Specification. The Examiner is clearly using hindsight to combine the teachings of Fuji, Kobayashi, Miki and Hitachi is directly against the holding of *In Re Kotzab*.

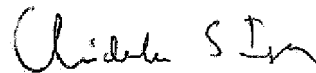
The Applicants respectfully submit that the patent office's grounds of rejection do not satisfy the Federal Circuit's rigorous standard for demonstrating that the claimed invention would have been obvious in view of the cited references.

Further to the amendments to the claims, the Applicants respectfully submit that minimizing space, facilitating measures for insulation and improving ease of installation of the snubber module with the semiconductor switch module are simultaneously achieved in the present invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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